

**REMARKS**

Claims 1, 3 through 11 and 14 through 16 are pending in this application. The specification has been amended to address formal issues, claims 1 and 3 through 11 amended, claims 2, 12 and 13 cancelled, and new claims 14 through 16 added. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally disclosure. Applicant submits that the present Amendment does not generate an new matter issue.

**Claim Objection.**

The Examiner objected to claim 1, identifying a perceived informality and courteously recommending remedial language. In response, claim 1 has been amended in the manner suggested by the Examiner, thereby overcoming the stated basis for the imposed objection. Accordingly, withdrawal of the objection to claim 1 is solicited.

**Claims 1 through 13 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Chiu et al.**

In the statement of the rejection the Examiner admitted to various differences between the claimed invention and the optical module disclosed by Chiu et al. Rather than following judicial mandates by providing a factual basis for the Examiner's conclusions, the Examiner merely asserted that these differences are not linked to solving any particular problem and, hence, the claimed inventions would have been obvious. The Examiner also concluded that one having ordinary skill in the art would have motivated to employ a resin block, without providing any factual basis. This rejection is traversed.

Applicant is unaware of any legal principle which justifies the conclusion that the claimed subject matter as a whole would have been obvious within the meaning of 35 USC §103 notwithstanding admitted differences between the claimed invention and the applied prior art, merely because it is **perceived** that such differences have not been disclosed to cure any particular problem. Applicant would stress that regardless of the source of motivation, the Examiner must still provide **facts** to establish the requisite motivation to support the obviousness conclusion under 35 U.S.C §103. See, for example *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 63 USPQ2d 1374; *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). No such facts have been provided. Accordingly, the Examiner's rejection is traversed for lack of the requisite factual basis to support the asserted motivation.

At any rate, in order to expedite prosecution, the claims have been amended to clarify that the block holds the circuit board (substrate) and the optical sub-assembly, and the leads of the optical sub-assembly and the circuit board, of which relative positions are defined by the block, are electrically connected to each other. No such structure is disclosed or suggested by Chiu et al.

Indeed, according to the optical module disclosed by Chiu et al., the circuit board 250 is held by the signal leads 201 provided with the receiver 111, which receiver may be considered to correspond to the optical sub-assembly of the present invention. Therefore, relative positions of the receiver 111 and the circuit board 250 are unstable, as illustrated in Fig. 2 of Chiu et al. Thus, when the assembly illustrated in Fig. 2 is installed in the bottom frame 301, stress is generated at the connection portion between the leads 201 and the circuit boards 250.

Based upon the foregoing it should be apparent that the block 120 in the optical module disclosed by Chiu et al. does not hold the circuit boards, and Chui does not teach a block which can define the relative positions of the components of the optical module.

Applicants separately argue the patentability of **claims 3, 15 and 16**.

Specifically, according to the optical module disclosed by Chiu et al., the signal leads 201 are provided with the receiver 111 (corresponding to the optical sub-assembly of the present invention). However, in accordance with the present invention, the supporting portion and the pressing portion are provided with their block. Therefore, the circuit board (substrate) is rigidly held by the block.

Moreover, the relative positions between the optical sub-assembly and the circuit board in accordance with the present invention are defined by the block, and then the circuit board is electrically connected to the leads. Accordingly, the assembly including the optical sub-assembly and the circuit board can be readily installed on a lower casing.

As previously pointed out, the block 120 of the device disclosed by Chiu et al. does not have the supporting portion and the pressing portion. Further, Chiu et al. do not disclose or suggest the use of a block which can define the relative positions of components of the optical module.

Applicant also separately argues the patentability of **claim 14**. Specifically, in accordance with claim 14, the surface of the receptacle of the lower case has an opening in which the optical sub-assembly passes. No such structure is disclosed by Chiu et al.

The Examiner's assertion that the rail 305A corresponds to the surface of the receptacle of the lower case is not accurate. Clearly, as shown in Fig. 3 of Chiu et al., it is not possible that the optical sub-assembly passes the rail 305A.

Applicant further separately argues the patentability of **claim 5**. The Examiner suggested that the tip 355A disclosed by Chiu et al. corresponds to the projection of the lower casing. This determination is not accurate.

Specifically, in accordance with the present invention, the block is secured by the projection of the casing and the surface of the receptacle. In the device of Chiu et al., the block 120 is disposed between the tip 355A and the receptacle. However, it is not apparent wherein, the Examiner did not identify any basis upon which to determine that, the block disclosed by Chiu et al. is secured by the tip 355A and the receptacle.

Applicant also separately argues the patentability of **claim 10**. The Examiner suggested that the signal leads 201 corresponds to the holder of the present invention. This is not accurate.

In accordance with the present invention, the holder surrounds the optical sub-assembly, and holds the optical sub-assembly with respect to the block. In contradistinction to the present invention, the signal leads 204 of the device disclosed by Chiu et al. cannot hold the optical sub-assembly with respect to the block.

Based upon the foregoing it should be apparent that there are significant differences between the claimed optical module and method and those disclosed by Chiu et al. Further, there is no apparent factual basis upon which to predicate the conclusion that one having ordinary skill

in the art would somehow have been realistically impelled to deviate from the teachings of Chiu et al. to arrive at the claimed inventions absent, of course, improper reliance upon Applicant's disclosure. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

Applicant, therefore, submits that the imposed rejection of claims 1 through 13 under 35 U.S.C. § 103 for obviousness predicated upon Chiu et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

**New claims 14 through 16.**

New claims 14 through 16 are clearly free of the applied prior art for reasons previously argued. Applicant would stress that Chiu et al. neither disclose nor suggest an optical module, or method, as claimed comprising an optical sub-assembly having leads and a substrate connected to the leads of the optical sub-assembly, wherein the relative positions of the leads of the optical sub-assembly and the circuit boards are defined by the block and are electrically connected to each other. Further, Chiu et al. neither disclose nor suggest providing a surface of the receptacle of the lower case of the opening in which the opening in which the optical sub-assembly passes.

Based upon the foregoing it should be apparent that the imposed objection and rejection have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

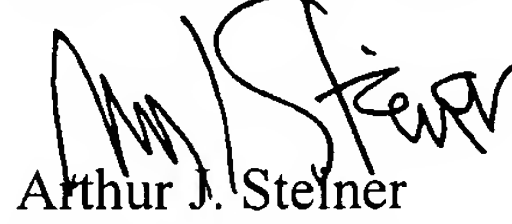
To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

**Application No.: 10/655,589**

including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Arthur J. Steiner

Registration No. 26,106

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 AJS:MWE:ntb  
Facsimile: 202.756.8087  
**Date: July 11, 2005**

**Please recognize our Customer No. 20277  
as our correspondence address.**

WDC99 1104104-1.050212.0533